

### **REMARKS**

In response to the final action dated December 1, 2008, Applicants submitted a reply on March 2, 2009 including proposed amendments in which claim 4 was cancelled and the allowable subject matter thereof was added to independent claim 1, placing claim 1 in condition for allowance. Additionally, claims 18-21, 23, 24, and 51 were cancelled in the proposed amendment. Accordingly, Applicants believed that the proposed amendment would place all claims in condition for allowance, since all claims had been cancelled except amended claim 1, those depending from claim 1, and those which had previously been allowed. Nevertheless, the advisory action dated March 17 was issued, in which non-entry of the proposed amendments was indicated by marking boxes 3 and 3(a). The advisory action noted that "due to including [the allowable subject matter of] claim 4 into the independent claim [1]," the scope of claims 5, 17, 34, and 49 would be changed, "therefore requiring additional consideration and possible search."

#### **No further search is required**

Applicants note that further search of the prior art for dependent claims cannot be required by the addition of allowable subject matter to an independent claim. By its very definition, allowable subject matter is not shown in the prior art, and any claim including same, whether dependent or independent, requires no further search of the prior art. Therefore, non-entry of the previously-filed amendments to the claims cannot be based on a need for further search caused by the proposed amendment to claim 1. If any further search were required, it would not be due to the proposed amendments, and rather than an advisory action, the final rejection should be withdrawn and a new action issued.

#### **Entry of the amendments is permitted**

Although, as discussed at MPEP section 714.13 II, proposed amendments to finally-rejected claims are not entered as a matter of right, the MPEP also makes clear that an amendment that "places the application in condition for allowance ... should be processed as an allowance." *See* MPEP 706.07(f)(I)(C)(1).

Additionally, "where an amendment merely cancels claims, adopts examiner suggestions, ... or in some other way requires only a cursory review by the examiner," no showing under 37 CFR 1.116 is necessary. In this case, the amendment merely cancels claims and places claim 1

in condition for allowance. Furthermore, because there are only four dependent claims, the proposed amendment requires very little review by the Examiner. There is no reason why entry of the proposed amendment could not be granted in this case.

**Entry of the amendments is appropriate**

With regard to the need for further consideration, Applicants note that only four claims were affected by the proposed amendment to claim 1, and a “proposed amendment should be given sufficient consideration to determine whether the claims are in condition for allowance.” See MPEP 714.13 III (Emphasis added). Here, the Examiner should review the proposed amendment to determine whether dependent claims 5, 17, 34, and 49 would be allowable if the proposed amendment were entered. If, after such consideration, claims 5, 17, 34, and 49 would not be in condition for allowance, then “the examiner should provide an explanation as to the reasons why the proposed amendment raises new issues,” and, “if the proposed amendment raises the issue of new matter, the examiner should identify the subject matter that would constitute new matter.” See MPEP 714.13 III.

Accordingly, for at least the foregoing reasons, reconsideration of the non-entry of the proposed amendments submitted in the reply of March 2, 2009 is requested. Moreover, because the proposed claim amendments place all claims in condition for allowance, issuance of a notice of allowance is requested.

Payment of the requisite fee for a two-month extension of time is made concurrently by deposit account authorization on the Electronic Filing System (EFS). Please apply any other charges or credits to deposit account 06-1050.

Respectfully submitted,

Date: 21 April 2009

/George P. Bonanto/  
George P. Bonanto  
Reg. No. 59,717

Fish & Richardson P.C.  
1425 K Street, N.W., 11th Floor  
Washington, DC 20005-3500  
Telephone: (202) 783-5070  
Facsimile: (877) 769-7945